

Hearing:
June 29, 1999

Paper No. 24
TJQ

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 29, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SMJ Group, Inc.

Serial Nos. 75/026,413; 75/026,414; and 75/052,422

William M. Ried and Kim A. Walker of Willkie Farr &
Gallagher for applicant.

K. Margaret Le, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Hanak, Quinn and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed to register the mark
BROOKLYN DINER USA - THE FINER DINER and the marks shown
below

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

all for "restaurant services."¹

The Trademark Examining Attorney has refused registration in each application under Section 2(e)(3) of the Trademark Act on the ground that the mark, when used in connection with the services, is primarily geographically deceptively misdescriptive of them.

When the refusals to register were made final, applicant appealed. Applicant and the Examining Attorney filed briefs,² and a consolidated oral hearing was held before the Board. Because of the essentially identical issues involved in these three appeals, the Board shall explain our decisions in these cases in one opinion.

In order for a mark to be primarily geographically deceptively misdescriptive, the mark must (1) have as its primary significance a generally known geographic place,

¹ Respectively, application Serial No. 75/026,414, filed November 29, 1995, alleging dates of first use of November 15, 1995; application Serial No. 75/026,413, filed November 29, 1995, alleging dates of first use of November 15, 1995; and application Serial No. 75/052,422, filed February 2, 1996, alleging dates of first use of September 1, 1995. All of the applications include disclaimers of the terms "USA," "Finer" and "Diner." The applications to register the composite marks include statements that the lining and stippling are features of the marks and are not intended to indicate color. It is noted that applicant owns another application, Serial No. 74/694,837, which is on appeal but currently under suspension pending a final determination in these appeals.

² The briefs include supplemental briefs which were allowed by the Board.

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

and (2) identify services that purchasers are likely to believe mistakenly are connected with that location, that is, purchasers would make a services/place association. In *re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); In *re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In *re Loew's Theaters, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and In *re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

In support of her *prima facie* case, the Examining Attorney offered evidence to show that Brooklyn is a place that is neither obscure nor remote, and that restaurants, including diners, are located in Brooklyn. In particular, the Examining Attorney introduced a listing for "Brooklyn" in *Webster's New Geographical Dictionary* (1984) and *The American Heritage Dictionary of the English Language* (3d ed. 1992). This evidence shows that Brooklyn is a borough of New York City with a population exceeding two million. The Examining Attorney also introduced excerpts retrieved from the NEXIS database and telephone directories to show that restaurants and, specifically, diners are located in

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

Brooklyn.³ The Examining Attorney maintains that the evidence shows "that diners located in Brooklyn exist in sufficient number to cause a consumer to believe that the mark BROOKLYN DINER identifies a diner in Brooklyn."
(appeal brief, p. 5)

Applicant readily acknowledges that "Brooklyn" is primarily a geographic term and that applicant's services do not originate in Brooklyn. Thus, applicant focuses, as has the Examining Attorney, on the central issue in these cases: whether the public would believe that the restaurant services for which the marks are sought to be registered originate in the geographic place named in the mark when, in fact, the services do not originate in that geographic place. In connection with this central issue of a services/place association, applicant has submitted the declarations of Robert A. Rosenberg, an attorney at the law firm representing applicant in the involved applications. The declarations are accompanied by numerous documents. These materials include the following: a reference to

³ Applicant rightly has criticized some of the NEXIS excerpts introduced by the Examining Attorney. As pointed out by applicant, some of the articles are duplicative, and many are written about just three Brooklyn restaurants (Gage and Tollner, Junior's and Nathan's). Further, some of the other articles clearly are inapplicable to the issue in this case (see, for example, the one regarding a restaurant located on Brooklyn Avenue in Kansas City, Missouri).

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

"Brooklyn" as the "City of Homes" and the "Borough of Churches" in *The Columbia Lippincott Gazetteer of the World* (1962); a reference to "Brooklyn" in *Names & Nicknames of Places & Things* (1987) and in *The World Almanac* (1994); excerpts from the Brooklyn Yellow Pages which highlight historical sights and landmarks, none of which are restaurants or diners; an entry for "Brooklyn" in *Webster's New Geographical Dictionary* (1984) listing the various industries of Brooklyn, with no mention of the restaurant trade or diners; excerpts from a book, *American Diner: Then and Now* (1993) about diners in the United States, referring to nine diners located in Brooklyn in its directory of 1,291 diners in this country; excerpts retrieved from the NEXIS database showing that the terms "diner" and "restaurant" are cited more frequently in connection with geographic locations other than Brooklyn (such as New York, New Jersey and Los Angeles); nine third-party registrations and nine third-party applications for marks which include, as a portion thereof, the terms "Brooklyn," "Bronx," or "Manhattan;" file wrappers for two of these registrations; copies of registrations of applicant's marks issued in Mexico, and a document indicating that at least one of applicant's marks has been approved in Canada; excerpts from printed publications,

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

including travel guides, which refer to applicant's restaurant, with one article about the opening of several "theme" restaurants (including applicant's) on West 57th Street in Manhattan; and a menu from applicant's restaurant and menus from other diners. Mr. Rosenberg also has described, based on his personal visit, the décor of applicant's restaurant: "I observed prominent photographs of the beach at Coney Island, the Brooklyn Bridge and the Cyclone Roller Coaster on the Coney Island boardwalk, and a large mural of the Brooklyn Dodgers playing at Ebbets Field...I also noted it is furnished with un-diner like materials such as dark wood, and contains a wine bar that serves 20 California, Italian, French and Australian wines by the glass."

The Examining Attorney maintains that restaurants and, in particular, diners exist in sufficient number in Brooklyn that consumers, upon encountering applicant's mark, would make a services/place association, mistakenly so in the present cases.

Applicant, contends, on the other hand, that the record does not support a services/place association. Applicant asserts that its evidence shows that Brooklyn is not known for restaurants and diners "beyond what is virtually universal for cosmopolitan centers." (brief, pp.

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

4-5) Applicant goes on to argue that the marks "convey nostalgic overtones of the common past of all Americans," a theme which is carried out, according to applicant, by the restaurant's décor (with photographs of Brooklyn landmarks). In arguing the merits of its position in supplemental briefs, applicant places significant reliance on the Board's recent decision in the case of *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369 (TTAB 1999) wherein the Board found the designation COOPERSTOWN to be not primarily geographically deceptively misdescriptive for restaurants which are not located in Cooperstown, New York.

Based on the record before us in this appeal, we find that it is reasonable to assume that consumers encountering applicant's BROOKLYN DINER marks will mistakenly believe that the restaurant services have their origin in Brooklyn or are otherwise connected with Brooklyn. We acknowledge that restaurant services are "ubiquitous" and that the Board, in *In re Municipal Capital Markets Corp.*, supra, has stated that "the Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location." We find that the instant record satisfies the test.

We note that the décor of applicant's restaurant includes photographs of the Brooklyn Bridge, Coney Island and the Brooklyn Dodgers at Ebbets Field.⁴ See: In re Municipal Capital Markets Corp., supra at 1372 (J. Simms, concurring) Of particular importance in this case is applicant's menu. Although applicant, in connection with its "theme" arguments, has pointed to other language in the menu, conspicuously overlooked by both applicant and the Examining Attorney is the following language on the back of the menu:

Where does Brooklyn fit in? Well, Brooklyn is--and always has been--the ultimate melting pot in America. And so it was the logical place to turn when we began our search more than two years ago, for the ultimate "American ethnic" recipes. We spent nearly two years digging into **Brooklyn's incredibly rich and diverse culinary past** (and we found ourselves on several occasions getting recipes from old-timers who live now in Brooklyn nursing homes); and we spent months upon months (and continue to do so) putting those recipes to the test. And while we've taken a few liberties (as you can see from the menu), **we've gone to extreme lengths to remain faithful to this important--and too often neglected--culinary tradition.** (emphasis added)

⁴ We also would note the stylization of the term "Brooklyn" in applicant's composite marks is reminiscent of that used by the old Brooklyn Dodgers baseball team.

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

In the next paragraph, the menu indicates that the borough of Brooklyn has been "the *culinary* inspiration for our restaurant." (emphasis in original)

The reference, in applicant's own words, to "Brooklyn's incredibly rich and diverse culinary past" seriously undermines applicant's contention that consumers would not associate its restaurant services with Brooklyn. To be clear, we are not finding that the Examining Attorney has shown that Brooklyn is *noted for* its restaurants or cuisine (which she is not required to do). Rather, we find that applicant's own words in its menu, coupled with the décor of the restaurant, present "that something more" to establish a services/place association. Thus, we conclude that the public would mistakenly believe that applicant's restaurant services rendered under applicant's marks originate in Brooklyn. See: *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1989).

In making our decision, we recognize, of course, that applicant's marks include more than just the word "BROOKLYN." Our view, however, is that each of the marks, when viewed in its entirety, projects a primarily geographic significance, with the addition of the other wording not detracting in the least from this primary geographic significance of the mark. If anything, as

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

pointed out by the Examining Attorney, the inclusion of the term "USA" in each of the marks reinforces the primary geographic significance of the mark as a whole. Applicant has not provided any facts, and indeed, has not even argued that the primary geographic significance of the mark is lost by the addition of the other words and/or design. The determination of registrability under Section 2(e)(3) should not depend on whether the mark is unitary or composite. In re Wada, supra at 1540-41; and In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986). See also: In re Nantucket Inc., supra, at 893, n. 7; and In re Handler Fenton Westerns, Inc., 214 USPQ 448 (TTAB 1982).

Two other points raised by applicant require mention. First, applicant has relied upon several third-party registrations and applications for marks which include geographic terms such as "Brooklyn," "Manhattan" and "Bronx." Applicant asserts that the Office's approvals of these marks "illustrate the need for the Trademark Office to treat similarly situated applicants under the same rules and requirements in the same manner." (brief, p. 10) Suffice it to say, this evidence is of little help in determining the registrability of the marks at issue in this case. As often noted by the Board, each case must be

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

decided on its own set of facts, and we are not privy to the facts involved with these registrations and applications. While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's marks are registrable.

Second, applicant relies upon the fact that it has obtained registrations for its marks in Mexico, and that its marks have been passed to publication in Canada. Applicant argues that "[t]he United States should recognize the actions taken by both its NAFTA (The North American Free Trade Enactment Act) treaty partners and pass applicant's mark to publication" and that, to hold otherwise, "the Examining Attorney would afford United States citizens less protection in their own country than they receive in other treaty countries." (brief, p. 14) Simply put, these registrations and applications, examined under trademark rules and precedential case law different from that in the United States, are irrelevant to our analysis. In re John Harvey & Sons Ltd., 32 USPQ2d 1451, 1453 n. 5 (TTAB 1994).

Ser Nos. 75/026,413; 75/026,414; and 75/052,422

Decision: The refusal in to register is affirmed in each instance.

E. W. Hanak

T. J. Quinn

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Ser Nos. 75/026,413; 75/026,414; and 75/052,422